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In re Application of : DECISION ON
Buryak et al :
PCT No.: PCT/AU2004/000987 :
Application No: 10/565,691 :
Int. Filing Date: 03 February 2004 : PETITION UNDER
Priority Date: 23 July 2003 :
Attorney's Docket No.: 2085.005US1 :
For: OPTICAL DATA CARRIER SYSTEM : 37 CFR 1.47(a)

This is in response to the "RULE 1.47(a) PETITION TO FILE APPLICATION BY OTHER THAN INVENTOR" filed on 26 December 2006. The petition fee of \$200.00 has been charged to petitioner's Deposit Account as specified in the petition.

BACKGROUND

On 03 February 2004, applicants filed international application PCT/AU2004/000,987, which claimed priority to an earlier application filed 23 July 2003.

On 23 January 2006, applicants filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath was submitted at such time.

On 26 July 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905), which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date that the declaration does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." The notice indicated that all of the items set forth must be submitted within two (2) months from the date of this Notice or by 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment.

On 26 December 2006, petitioner filed the present petition, a declaration in support of filing on behalf of omitted joint inventor Alexander Buryak.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1), (3) and (4) of 37 CFR 1.47(a) but not item (2).

Regarding item (1), petitioner has provided the petition fee of \$200.00 under 37 CFR 1.17(g).

Regarding requirement (2), although the statement by Bradley Forrest states that Mr. Buryak sent an e-mail on May 19, 2006 indicating that he would not cooperate with the prosecution of the above-identified application and that he did not sign any papers, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. It is unclear what documents were forwarded to Mr. Buryak because the petition refers only to the Combined Declaration and Power of Attorney papers and there is no statement referring to a copy of the application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP. 409.03(d) being sent to him.

Moreover, it is not clear from the petition that it was Bradley Forrest who performed the items listed in the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Forrest was not the person who performed the actions listed in the petition, petitioner will need to submit statements, with specific facts on the actions referred to by the petition by persons who have first-hand knowledge of such facts. In addition, the declaration by Dr. Ian Mann does elaborate the actions taken to obtain Mr. Buryak's signature.

Accordingly, the steps enumerated by Bradley Forrest are not sufficient to establish that Mr. Buryak has refused to sign the declaration.

Regarding item (3), petitioner has provided a statement of the last known address of the missing inventor.

Regarding item (4), petitioner has provided an executed declaration signed by Kazimir Kolossovski and Dimitri Yu Stepanov on their behalf and on the behalf of the nonsigning joint inventor Alexander Buryak.

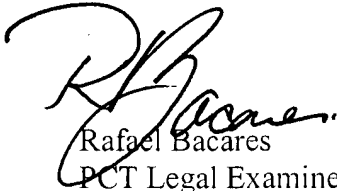
Consequently, the petition does not satisfy all the items under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'R. Bacares', is written over the printed name and title.

Rafael Bacares

PCT Legal Examiner

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